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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,874	01/14/2004	Gail Iannacone	23282-002	5191
21890	7590	08/23/2005	EXAMINER	
PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,874

Applicant(s)

IANNACONE, GAIL

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01142004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 5-6, 8-12, 15-16, 19-23 and 24-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Grim 5,392,534. Grim '534 discloses all the limitations of the claims including the following: a sole comprising a lower sole 74, a flexible upper sole 40, and a plurality of unamalgamated beads 32 disposed between the upper sole and the lower sole (see Figure 3); at least one strap 128 connected to the sole and configured to secure the sole to the bottom of a user's foot (places pressure on top of foot to help hold upper on foot); the beads are enclosed in a thin and flexible inner bag (bladder 18); the bag (bladder 18) is disposed between the upper and lower soles (see Figure 3); the beads are roughly spherical expanded thermoplastic beads (see col. 3, lines 11-14); the beads are roughly spherical expanded polystyrene beads (see col. 3, lines 11-14) having an average diameter between two thirds mm (approximately 1/38 inch) and one mm (approximately 1/25 inch) (see col. 3, lines 42-46); the plurality of beads comprises at least ten thousand beads ((size of beads with respect to size of shoe shown); an upper 12 connected to the sole and configured to secure the sole to the bottom of the user's foot; the lower sole having an upper surface (see Figure 3); sidewalls having an inner surface (see Figures 1, 3, 7); the sidewalls are connected to the lower sole so as to form a recess that is bounded by the inner surface of the sidewalls and the upper surface of the lower sole (see Figures 1, 3 and 7); a plurality of unamalgamated small beads 32 disposed in the recess (in bladder 18); a thin flexible upper sole 40 disposed on top of the beads and arranged to retain the beads within the recess (see Figure 3); the beads 32 are free to shift (not affixed to one another); the recess occupies an area that is at least half as large as the area of the upper

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sole (see Figure 3); at least one part of the recess is at least about one quarter inch deep (see Figure 3); the plurality of beads comprises at least ten thousand beads (size of beads versus size of shoe shown); the beads are in a bag (bladder 18); the upper sole 40 retains the beads within the recess by retaining the bag within the recess (see Figure 3); an upper 12 connected to at least one of the lower sole, the sidewalls and the upper sole and is adapted to hold the upper sole against the bottom of the user's foot (see Figure 3); the strap 128 being stuffed with beads (see Figures 10 and 11).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 7, 13, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grim 5,392,534 as applied to claims 1, 6, 11 and 16 above in view of either of Spence 3,449,844 or Nichols 6,061,928. Grim '534 as applied to claims 1, 6, 11 and 16 above discloses all the limitations substantially as claimed except for the sole being made of fabric. Nichols '928 and Spence '844 are examples of known soles in the art that are made of fabric to allow for a better feel between the sole and the user's foot as well as to protect the user's sole from being scratched during use of the shoe. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the upper sole of Grim '534, as applied to claims 1, 6, 11 and 16 above, out of fabric to aid in protecting the user's foot sole from being uncomfortable and scratched from the contact of the user's foot with the sole.

5. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grim 5,392,534 as applied to claims 1 and 11 above in view of Courian 4,843,736. Grim '534 as applied to claims 1 and

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11 above discloses all the limitations substantially as claimed except fro the upper sole being made of stretch jersey fabric. Courian '736 teaches that the material in a shoe that touches the user's foot can be made of stretch jersey fabric to make it feel softer against the user's skin and prevent irritation of the user's skin from use of the shoe. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the upper sole of Grim '534 as applied to claims 1 and 11 out of stretch jersey fabric to give the user a better feel of the shoe against the user's foot and prevent irritation of the user's foot from wearing the shoe.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on Form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick

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Primary Examiner
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